

S.N.: 10/559,919
Art Unit: 2617

REMARKS

Claims 1-35 are currently pending. Claims 1 and 10 have been amended for clarification. Claims 20 and 31-34 have been amended for clarification and to incorporate subject matter from claim 23. Claim 23 has been amended for clarification purposes only. Claim 35 has been added to enhance the scope of patent coverage and is supported by original claim 10. It is respectfully submitted that no new matter has been added.

Allowance of Claims 23-30

The Patent Office is thanked for allowing claims 23-30.

Regarding the Objection to Claims 20 and 23

The Patent Office objected to claims 20 and 23 on page 15, lines 8-12, of the Office Action dated July 11 2007. In a brief telephone conversation between Applicant's representative, Walter Malinowski, and Patent Examiner Brandon J. Miller, on September 20, 2007, Examiner Miller confirmed that there were no objections to claims 20 and 23.

In Response to the Rejection of Claims 1-22 and 31-34 under 35 U.S.C. 102(e) or 35

U.S.C. 103(a)

The Patent Office rejected claims 1, 3, 10, 12, 19, and 34 under 35 U.S.C. 102(e) as being anticipated by Whinnett, U.S. Published Patent Application No. 2004/0219919.

The Patent Office rejected claims 2, 4-9, 11, 13-18, and 20-22 under 35 U.S.C. 103(a) as being unpatentable over Whinnett, in view of Kadaba, U.S. Published Patent Application No. 2002/0172217.

The Patent Office rejected claims 31-33 under 35 U.S.C. 103(a) as being unpatentable over Whinnett in view of Kadaba and Seo, U.S. Patent No. 6,469,993.

Besides allowed independent claim 23, claims 1, 10, 20, and 31-34 are independent claims. Claims 1, 10, 20, and 31-34 have been amended.

Claim 1 recites as follows:

A method comprising: when a mobile station is in an autonomous mode of operation, autonomously transmitting data from the mobile station to a base station on a reverse channel; **in response to receiving an acknowledgment indication from the base station, that comprises a reverse channel assignment message for the mobile station**, switching the mobile station to a scheduled mode of operation, where, while in the scheduled mode, the mobile station provides the data transmission power

S.N.: 10/559,919
Art Unit: 2617

and the selected data transmission buffer status as a request; and transmitting data from the mobile station on an assigned reverse channel.

Claim 10 recites as follows:

An apparatus, comprising: an RF transceiver for conducting bidirectional wireless communications with a base station; and a data processor operating under the control of a stored program for, when the apparatus is in an autonomous mode of operation, autonomously transmitting from the apparatus to the base station on a reverse channel, **said data processor being responsive to a reception of an acknowledgment indication from the base station, that comprises a reverse channel assignment message for the apparatus**, for switching the apparatus to a scheduled mode of operation and for transmitting data from the apparatus on an assigned reverse channel, where, while in the scheduled mode, the apparatus provides the data transmission power and the selected data transmission buffer status as a request.

Claim 20 recites, in pertinent part, as follows:

receiving, from the base station in response, a power control bit, a data rate grant bit and an acknowledgment/non-acknowledgment indication, wherein there exist at least four R-SCH states and at least eight transitions between the R-SCH states, wherein the at least four R-SCH states include an R-SCH initialization state, an R-SCH autonomous state, an R-SCH scheduled state, and an R-SCH release state

Claim 31 recites, in pertinent part, as follows:

transmitting data from the mobile station to the base station over a reverse supplemental channel (R-SCH), wherein there exist at least four R-SCH states and at least eight transitions between the R-SCH states, wherein the at least four R-SCH states include an R-SCH initialization state, an R-SCH autonomous state, an R-SCH scheduled state, and an R-SCH release state

Claim 32 recites, in pertinent part, as follows:

said data processor being responsive to a reception of an acknowledgment indication from the base station for switching the mobile station to a scheduled mode of operation and for transmitting data from the mobile station to the base station over a reverse supplemental channel (R-SCH), wherein there exist at least four R-SCH states and at least eight transitions between the R-SCH states, wherein the at least four R-SCH states include

S.N.: 10/559,919
Art Unit: 2617

an R-SCH initialization state, an R-SCH autonomous state, an R-SCH scheduled state, and an R-SCH release state

Claim 33 recites, in pertinent part, as follows:

transmitting data packets from the mobile station transmitting data from the mobile station to the base station over a reverse supplemental channel (R-SCH), wherein there exist at least four R-SCH states and at least eight transitions between the R-SCH states, further comprising transmitting mobile station buffer activity bits and a data rate request bit, and receiving, from the base station in response, a power control bit, a data rate grant bit and an acknowledgment/non-acknowledgment indication, wherein the at least four R-SCH states include an R-SCH initialization state, an R-SCH autonomous state, an R-SCH scheduled state, and an R-SCH release state

Claim 34 recites, in pertinent part, as follows:

in the scheduled mode, the mobile station is configured to transmit a request by providing data transmission power information and selected data transmission buffer status information to the base station for granting a data transmission rate to the mobile station, wherein there exist at least four R-SCH states and at least eight transitions between the R-SCH states, wherein the at least four R-SCH states include an R-SCH initialization state, an R-SCH autonomous state, an R-SCH scheduled state, and an R-SCH release state

For a claim to be anticipated, usually each and every non-inherent claim limitation must be disclosed by a single reference (see MPEP 2131). The only independent claims rejected as anticipated by the Patent Office are claims 1 and 10. As claim 1 subject matter **“in response to receiving an acknowledgment indication from the base station, that comprises a reverse channel assignment message for the mobile station”** and claim 10 subject matter **“said data processor being responsive to a reception of an acknowledgment indication from the base station, that comprises a reverse channel assignment message for the apparatus”** is not disclosed by Whinnett, Whinnett cannot be an anticipatory reference and is treated below as a non-anticipatory reference.

Applicant’s invention addresses the problem of transitioning a mobile station from the autonomous to the scheduled transmission modes.

A 37 C.F.R. 1.131 affidavit is being submitted with this response to overcome the

S.N.: 10/559,919
Art Unit: 2617

effective filing date of April 30, 2003, of Whinnett. The attached exhibits A-D show that applicant was in possession of the claimed invention no later than April 1, 2002, a date that precedes the effective filing date of Whinnett. Accordingly, Applicant respectfully requests that the Patent Office withdraw Whinnett as a prior art reference.

Furthermore, to show conception and diligence in the United States where the patent application was drafted, Exhibits A to D are provided (any redaction has been for the purpose of protecting confidential information):

1. Exhibit A is a true copy of a docket history for Applicant's invention which shows the date of invention has been entered as May 10, 2002, which corresponds to the date the invention was received by Applicant's Intellectual Property Rights group, the company entered a decision date for the invention on April 25, 2003, and the invention disclosure was sent to outside counsel on May 5, 2003.
2. Exhibit B is a true copy of an invention report summary for Applicant's invention that is dated May 3, 2002, in the inventor's signature block. Note the attached word document at the first page, left column, of exhibit B. The title of that attachment is in date form and indicates April 1, 2002.
3. Exhibit C is a true copy of a July 1, 2002 email from an inventor referring to an April 1, 2002 version of the Auto to Scheduled Mode invention report. This indicates that the conception date of Applicant's invention was not later than April 1, 2002.
4. Exhibit D is a true copy of selected pages (page numbers 1, 3, 4, 6-11) from the April 1, 2002 version of the Auto to Scheduled Mode invention report referred to immediately above in item 3, attached as the word document to the invention report summary of item 2, and attached to the July 2002 email of item 3.
5. An international patent application (PCT/IB2003/002523) corresponding to the invention described in the invention report referred to above was filed on June 27 2003. The present application is a national stage entry from the international patent application, which claims priority to U.S. provisional patent application no. 60/477503, filed June 10, 2003.

S.N.: 10/559,919
Art Unit: 2617

Conception is therefore shown prior to April 30, 2003, and diligence is shown via the April 25, 2003, decision to file for patent protection, the May 5, 2003 submission to outside counsel for drafting, the U.S. provisional patent application filed June 10, 2003, and the international patent application filed June 27, 2003.

All exhibits are true copies with the exception of being labeled herein for identification and redaction of confidential information.

Thus, claims 1-22 and 31-35 are in condition for allowance.

The Patent Office is respectfully requested to reconsider and remove the rejections of the claims 1-22 and 31-34 under 35 U.S.C. 102(e) based on Whinnett or 35 U.S.C. 103(a) based on Whinnett in view of Kadaba or Whinnett in view of Kadaba and Seo and to allow all of the pending claims 1-35 as now presented for examination. An early notification of the allowability of claims 1-35 is earnestly solicited.

S.N.: 10/559,919
Art Unit: 2617



Respectfully submitted:

Walter J. Malinowski November 29, 2007

Walter J. Malinowski

Date

Reg. No.: 43,423

Customer No.: 29683

HARRINGTON & SMITH, PC

4 Research Drive

Shelton, CT 06484-6212

Telephone: (203)925-9400, extension 19

Facsimile: (203)944-0245

email: wmalinowski@hspatent.com

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450.

11.29.2007 Jessica Bee

Date

Name of Person Making Deposit